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FEB 03 2009

**OFFICE OF PETITIONS**

In re Application of :  
KOYAMA et al. : LETTER REGARDING  
Application No. 10/629,108 : PATENT TERM ADJUSTMENT  
Filed: 07/28/2003 :  
Atty Docket No. 03338CIP/HG :

This letter is in response to the "LETTER RE: PATENT TERM ADJUSTMENT," filed November 25, 2008. Pursuant to applicants' duty of good faith and candor to the Office, applicants request that the determination of patent term adjustment under 35 U.S.C. 154(b) be reviewed for accuracy.

The request for review of the initial Determination of Patent Term Adjustment is GRANTED to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the notice of allowance is **146 days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On November 11, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment is 289 days. On November 25, 2008, applicants submitted the instant comment.

Applicants request that the Office recalculate the period of patent term adjustment. Specifically, applicants direct the Office's attention to the filing of the amendment under 37 CFR

1.312 on May 14, 2008, as well as the filing of the petition to withdraw from issue on October 8, 2008.

A review of the application history confirms that determination of patent term adjustment under 35 U.S.C. 154(b) is incorrect. It is undisputed that the period of reduction of 30 days pursuant to 37 CFR 1.704 for the filing of a response on May 3, 2006, is correct. However, entry of additional periods of reduction is warranted.

On May 14, 2008, applicants submitted an amendment under 37 CFR 1.312 after the mailing of a notice of allowance, which under the circumstances of this application, is a ground for reduction of patent term adjustment under 37 CFR 1.704(c)(10).<sup>1</sup> The period of adjustment should have been reduced by the lesser period of 41 days, beginning on the date the amendment under 37 CFR 1.312 was filed, May 14, 2008, and ending on the mailing date of the Office action or notice in response to the amendment, June 23, 2008. Accordingly, a period of reduction of 41 days is being entered.

Additionally, applicants should have been assessed a delay for the filing of the petition to withdraw from issue, the request for continued examination (RCE) and the IDS on October 8, 2008, after the mailing of the notice of allowance on February 20, 2008 (and after payment of the issue fee on May 15, 2008). The Office mailed a response to the petition to withdraw from issue on October 14, 2008. Accordingly, the submission of the petition to withdraw from issue after the mailing of the notice of allowance is a proper basis under 37 CFR 1.704(c)(10) for

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<sup>1</sup> 37 CFR 1.704(c)(10) provides:

Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;

or

(ii) Four months;

reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping. See 37 CFR 1.704(c).

On November 18, 2008, a notice of allowance was mailed in response to the RCE and IDS filed October 8, 2008. A review of the IDS filed October 8, 2008, reveals that applicants did not include a statement under 37 CFR 1.704(d).<sup>2</sup> Thus, applicants failed to engage in reasonable efforts to conclude prosecution of the application.

Pursuant to 37 CFR 1.704(c)(10), a first period of reduction of 7 days should have been entered for the submission of the petition to withdraw from issue, counting the number of days beginning on the date the petition was filed, October 8, 2008, and ending on the mailing date of the response to the petition, October 14, 2008. Pursuant to 37 CFR 1.704(c)(10), a second period reduction of 42 should have been entered for the submission of the RCE and IDS, counting the number of days beginning on the date the RCE and IDS were filed, October 8, 2008, and ending on the mailing date of the Office action or notice in response to the RCE and IDS, November 18, 2008.

37 CFR 1.704(c) provides that "[c]ircumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application ... will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping." The first period of reduction of 7 days pursuant to 37 CFR 1.704(c)(10) totally overlaps with the second period

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<sup>2</sup> Pursuant to 37 CFR 1.704(d):

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

of reduction of 42 days. Accordingly, a single period of reduction of 42 days is being entered for these two periods of reduction.

Lastly, the record reveals that applicants should have been assessed an additional delay of 30 days pursuant to 37 CFR 1.704(c)(8).<sup>3</sup> It is undisputed that after filing a response on August 29, 2006, applicants filed Supplemental IDSs on September 21, 2006 and September 28, 2006. The record does not support a conclusion that the examiner expressly requested the filing of either Supplemental IDS. Further, a review of the Supplemental IDSs, filed September 21, 2006 and September 28, 2006, reveals that applicants did not include a proper statement under 37 CFR 1.704(d) in either Supplemental IDS. Thus, applicants failed to engage in reasonable efforts to conclude prosecution of the application. Accordingly, a period of reduction of 30 days is being entered.

It is notes that a further IDS was filed on October 24, 2008. The revised PTA should include any period of reduction for the filing of this IDS.

In view thereof, the correct patent term adjustment at the time of the mailing of the notice of allowance is **146 days** (289 days of Office delay - 143 days (30 + 30 + 41 + 42) of applicant delay).

As this letter was submitted as an advisement to the Office of an error in applicants' favor, the Office will not assess the \$200.00 fee as set forth in 37 CFR 1.18(e). The Office thanks applicant for applicants' good faith and candor in bringing this to the attention of the Office.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays

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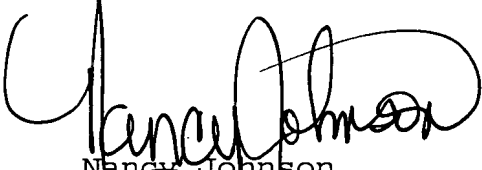
<sup>3</sup> Pursuant 37 CFR 1.704(c)(8) provides:

Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed.

under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicant will be notified in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Christina Tartera Donnell, Senior Petitions Attorney, at (571) 272-3211.



Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

Enclosure: Copy of updated PAIR screen

## PTA Calculations for Application: 10/629108

Application Filing Date:	07/28/2003	PTO Delay (PTO):	289
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	30
Post-Issue Petitions:	0	Total PTA (days):	146
PTO Delay Adjustment:	-113		

## File Contents History

Number	Date	Contents Description	PTO	APPL	START
138	02/02/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		30	
137	02/02/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		42	
136	02/02/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		41	
123	11/18/2008	MAIL NOTICE OF ALLOWANCE			
122	11/18/2008	ISSUE REVISION COMPLETED			
121	11/18/2008	DOCUMENT VERIFICATION			
120	11/18/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
119	11/17/2008	NOTICE OF ALLOWABILITY			
118	11/14/2008	MAIL-PETITION DECISION - DISMISSED			
117	11/14/2008	PETITION DECISION - DISMISSED			
116	10/08/2008	REFERENCE CAPTURE ON IDS			
115	10/08/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
111	10/08/2008	DATE FORWARDED TO EXAMINER			
110	10/08/2008	REQUEST FOR CONTINUED EXAMINATION (RCE)			
109	11/13/2008	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
98	10/08/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
97	10/08/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
96	10/14/2008	MAIL-RECORD PETITION DECISION OF GRANTED TO WITHDRAW FROM ISSUE			
95	10/14/2008	RECORD PETITION DECISION OF GRANTED TO WITHDRAW FROM ISSUE			
94	10/08/2008	WORKFLOW - REQUEST FOR RCE - BEGIN			
93	10/08/2008	PETITION ENTERED			

92	05/08/2008	PETITION ENTERED			
91	06/23/2008	MAIL RESPONSE TO 312 AMENDMENT (PTO-271)			
89	06/19/2008	RESPONSE TO AMENDMENT UNDER RULE 312			
88	05/14/2008	AMENDMENT AFTER NOTICE OF ALLOWANCE (RULE 312)			
87	05/20/2008	APPLICATION IS CONSIDERED READY FOR ISSUE			
86	05/15/2008	ISSUE FEE PAYMENT VERIFIED			
85	05/15/2008	ISSUE FEE PAYMENT RECEIVED			
84	01/24/2008	MISCELLANEOUS INCOMING LETTER			
83	02/25/2008	EXPORT TO INITIAL DATA CAPTURE			
82	02/20/2008	MAIL NOTICE OF ALLOWANCE	155		75
81	06/26/2007	ISSUE REVISION COMPLETED			
80	06/26/2007	DOCUMENT VERIFICATION			
79	06/26/2007	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
78	06/25/2007	NOTICE OF ALLOWABILITY			
77	06/13/2007	MISCELLANEOUS INCOMING LETTER			
76	06/01/2007	DATE FORWARDED TO EXAMINER			
75	05/18/2007	RESPONSE AFTER NON-FINAL ACTION			
74	09/21/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
73	09/21/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
72	06/05/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
71	06/05/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
70	05/03/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
69	05/03/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
68	03/21/2007	MAIL NON-FINAL REJECTION	82		61
67	03/19/2007	NON-FINAL REJECTION			
66	09/28/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
65	08/29/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
64.7	09/28/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			

64	09/28/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
63.7	08/29/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
63	08/29/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
62	02/26/2007	DATE FORWARDED TO EXAMINER			
61	08/29/2006	REQUEST FOR CONTINUED EXAMINATION (RCE)			
60	02/26/2007	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
59	02/26/2007	CASE DOCKETED TO EXAMINER IN GAU			
58	01/08/2007	FINISHED INITIAL DATA CAPTURE			
57	08/29/2006	WORKFLOW - REQUEST FOR RCE - BEGIN			
56	06/22/2006	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
55	06/19/2006	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT			
54	06/02/2006	EXPORT TO INITIAL DATA CAPTURE			
53	05/30/2006	MAIL NOTICE OF ALLOWANCE			
52	05/25/2006	ISSUE REVISION COMPLETED			
51	05/25/2006	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
50	05/25/2006	CASE DOCKETED TO EXAMINER IN GAU			
49	05/25/2006	NOTICE OF ALLOWABILITY			
48	05/11/2006	DATE FORWARDED TO EXAMINER			
47	05/03/2006	RESPONSE AFTER NON-FINAL ACTION		30	45
46	05/03/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
45	01/03/2006	MAIL NON-FINAL REJECTION			
44	11/16/2005	NON-FINAL REJECTION			
43	09/16/2005	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
42	09/16/2005	REFERENCE CAPTURE ON IDS			
41.7	09/16/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
41	09/16/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
40	09/26/2005	DATE FORWARDED TO EXAMINER			
39	09/16/2005	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			



38	09/26/2005	DATE FORWARDED TO EXAMINER			
37	09/16/2005	REQUEST FOR CONTINUED EXAMINATION (RCE)			
36	09/26/2005	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
35	09/16/2005	WORKFLOW - REQUEST FOR RCE - BEGIN			
34	06/17/2005	MAIL FINAL REJECTION (PTOL - 326)			
33	06/16/2005	FINAL REJECTION			
32	05/26/2005	DATE FORWARDED TO EXAMINER			
31	05/17/2005	RESPONSE AFTER NON-FINAL ACTION			
30	04/25/2005	CORRESPONDENCE ADDRESS CHANGE			
29	02/22/2005	MAIL NON-FINAL REJECTION			
28	02/18/2005	NON-FINAL REJECTION			
27	12/20/2004	REFERENCE CAPTURE ON IDS			
26.7	12/20/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		0	24
26	12/20/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
25	01/15/2005	DATE FORWARDED TO EXAMINER			
24	12/20/2004	RESPONSE TO ELECTION / RESTRICTION FILED			
23	12/20/2004	WORKFLOW INCOMING AMENDMENT IFW			
22	11/19/2004	MAIL RESTRICTION REQUIREMENT	52		-1
21	11/18/2004	REQUIREMENT FOR RESTRICTION / ELECTION			
20	04/29/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
19	04/29/2004	CASE DOCKETED TO EXAMINER IN GAU			
18	10/23/2003	PRELIMINARY AMENDMENT			
17	04/25/2004	CASE DOCKETED TO EXAMINER IN GAU			
16	03/02/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
15	10/23/2003	PRELIMINARY AMENDMENT			
14.7	10/22/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
14	10/22/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
13	12/12/2003	APPLICATION RETURN FROM OIPE			
12	12/12/2003	APPLICATION RETURN TO OIPE			
11	12/12/2003	APPLICATION DISPATCHED FROM OIPE			
10	12/12/2003	APPLICATION IS NOW COMPLETE			

9	10/22/2003	ADDITIONAL APPLICATION FILING FEES			
8	07/28/2003	CLAIM PRELIMINARY AMENDMENT			
7	10/22/2003	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
6	10/20/2003	NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED			
4	10/11/2003	CASE CLASSIFIED BY OIPE			
3	10/11/2003	CLEARED BY OIPE CSR			
2	09/19/2003	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	07/28/2003	INITIAL EXAM TEAM NN			

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### **EXPLANATION OF PTA CALCULATION**

### **EXPLANATION OF PTE CALCULATION**

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